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EXAMINER

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Technology Center 2100

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/648,715
Filing Date: August 25, 2000
Appellant(s): HICKMAN ET AL.

Paul L. Hickman, Reg. No. 28,516
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed on 8/10/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

For the above reasons, it is believed that the rejections should be sustained.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-18 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). The grouping of claims is not done properly, because the statement indicated as two groups whereas the 3 groups of claims are listed. Examiner is considering as a typo error.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

US Patent 5,930,471	Milewski et al.	7-1999
JP Patent 4,111,43936	Ariyama et al.	5-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-5, 7, 9, 11-14, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski et al. (US Patent 5,930,471) as applied to claims above, and further in view of Ariyama et al. (JP Patent 4,111,43936). This rejection is set forth in Final Office Action, Paper No. 9.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. §103(a), which forms the basis for all obviousness rejections set forth in this Office action:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made."

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2. Claims 1, 3-5, 7, 9, 11-14, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski et al. (US Patent 5,930,471) and in view of Ariyama et al. (JP Patent 4,111,43936).

3. As per independent claims 1,5, 7, 9, 12-14, 17-18, Milewski rendered by the following:

“opening a docketing program” at Fig. 7, col. 8, lines 30-37;

“running a report” at Fig. 8, col. 9, lines 16-25 and Table 5;

“saving the report for further processing” at Fig. 1, col. 6, lines 2-19.

“for a reminder notification action, obtaining all action items within a given range and processing the action items into at least one action item report and e-mailing the at least one action item report to at least one designated recipient” at Fig. 6, col. 8, lines 21-24;

“for a report notification action, obtaining a list of completed action items in a given range and processing the list of completed action items into at least one completed action report and e-mailing the at least one completed action report to at least one designated recipient” at Fig. 6, col. 8, lines 9-21.

Milewski does not explicitly teach determining the time for sending reminder notification. However, Ariyama teaches the following:

“determining that it is a time for at least one of a reminder notification action and a report notification action” (interpreted time as period) at Fig. 1, page 1,

paragraph - SOLUTION.

Thus, it would have been obvious to one ordinarily skilled in the art at the time of the invention to incorporate time for sending reminder notification. Milewski and Ariyama are combined to relate reminder and report notification on time basis. In order to send an automatic reminder notification a waiting period setting is essential.

4. As per dependent claims 3-4, 11, 16, Milewski teaches the following:
"reading the saved report into memory" at Fig. 9, col. 9, lines 26-29;
"parsing the report into items" at Fig. 9, col. 9, lines 35-42;
"filtering out unwanted items" at Fig. 9, Table 5, col. 9, line 42 to col. 10, line 11.

(11) Response to Arguments

A. The Examiner made improper objections to the drawing.

The Examiner respectfully disagrees with the Appellant because the Examiner found several mistakes in the drawings and the same thing has been brought to the attention of the Appellant. For example, In Fig. 1 – the element number 16 and 18 there is no distinction is shown and if labeled properly this kind of misinterpretation can be eliminated. Another drawing has an error, for example, in Fig. 7 – element number 706 is used to designate both action types as post card and file reminder. The final Office Action listed more details. The quality of drawings is very unprofessional and unethical.

~~In addition to this, USPTO Draftsperson objected all drawings i.e., Fig. 1-12 and Form PTO-948 mailed to the Appellant with the first Office Action on 3/12/2003.~~

B. Claims 1, 3-5, 7, 9, 11-14 and 16-18 were improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski et al. (US Patent 5,930,471) in view of Ariyama et al. (JP Patent 4,111,43936).

Group 1

Claims 1 - The appellant claims a method for electronic mail notification. The prior art used to reject this claim are Milewski et al. (US Patent 5,930,471) hereinafter Milewski and Ariyama et al. (JP Patent 4,111,43936) hereinafter Ariyama. Milewski teaches a communications system to facilitate transactions between a sender and a plurality of recipients as part of an electronic messaging system, whereas Ariyama teaches a schedule management system effectively supply the schedule reminding notification to a user. The Appellant argument on page 6 the last paragraph to page 7 the first paragraph, two lines that the quotation from Milewski appears to have no relationship to opening a docketing program nor does Fig. 7. The Examiner respectfully disagrees with the Appellant because Milewski teaches this limitation (Fig. 7, col. 8, lines 30-37), the operation 701 is the beginning operation the sender uses station 14 to access the controller 12 using conventional stored program instructions. It can be clearly interpreted the stored program as docketing program. The stored program has to be called, executed or opened. This stored program can only communicate with system and activate the object response template. Appellant might be looking for an exact word as "docketing". Whether a docketing program or stored program is a computer programming instructions and it is well know in the art. The stored programs are available for execution whenever the database is working, They are loaded with database loading, Just like when you turn on the computer the windows are ready and window programs are ready for execution. Further, Appellant argument on page 7, first paragraph to last paragraph as Applicant cannot find any support for the Examiner's assertion that "running a report". Again, the Examiner respectfully disagrees with the

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Appellant because Milewski teaches this limitation (Fig. 8, col. 9, lines 16-25, Table 5), the operation 809 updates the action message according to the responses or lack of responses from the recipients. Running a report is nothing but creating information to take further action. The sender receives the reply or response from the controller in order to take further action. The pseudo code reference is given for further clarification, a person of ordinary skill in the data processing art can understand. Further, Appellant argument on page 8, first paragraph, regarding the limitation "saving the report for further processing." Milewski teaches this limitation (Fig. 1, col. 6, lines 2-19) as the messages and responses (reports) received from the controller are stored on DASD and made available to one or more recipients. Further, Appellant argument on page 9, first paragraph, regarding the limitation of a report notification, obtaining a list of completed action items and emailing. Further stated as again neither Fig. 6 nor the above quotation are even vaguely related to the claim limitation. The Examiner respectfully disagrees again with the Appellant because Milewski teaches this limitation (Fig. 6, col. 8, lines 9-21), the Fig. 6 shows a summary prepared by the controller indicating the status of message distributed to the recipients. The summary clearly indicates that it is a report and the designated recipient in this case is a sender of the message and it can be understood that the report is very essential to the sender and it sent electronically. The recipient can send this report to others through a computer or email. The stored responses are made available to one or more recipients of the message (col.6, lines 25-28). Further, Appellant argument on page 9, last paragraph as Applicant asserts that Milewski does not explicitly or implicitly teach the

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limitation of determining time for sending reminder notification. In response to this argument, the Examiner agrees and for this reason the second reference by Ariyama is brought in. Ariyama teaches this limitation (Fig. 1, page 1, paragraph - SOLUTION) as the reminding notification with schedule information included in a notification period and also the reminder notification condition can be edited. One skilled in the data processing art can understand even though it is a machine translated one.

Claim 3 – is a dependent of claim 1, the appellant argument on page 11, second paragraph regarding the limitation “reading the saved report into memory” as this has no apparent relationship to the reading of saved report into memory. The examiner disagrees with the Appellant’s argument because Milewski do teach this limitation (Fig. 8, col. 9, lines 26-29). Milewski teaches as in operation 811, the controller may send notification of every response or may send a notification of only completed transactions. The examiner interpreted as the controller will store the information in the memory/hard disk and whenever needed or asked for will be read from and provided. Appellant is not convinced with his limitation and an explanation is given in the parenthesis. In the same way, a person having an ordinary skill in the data processing art can interpret in the same way as explained about the citation. Further, Appellant’s argument on page 11, 6th paragraph as there is no teaching of parsing in this quotation from Milewski. Again, Examiner respectfully disagrees with the Appellant because Milewski do teach this limitation (Fig. 5, col. 9, lines 35-42) as in response to the sender inquiry, the controller in the operation 903 displays the current status of messages sent by the sender and messages sent to the sender. If the controller cannot parse the command from the sender how can it respond to the sender with the report. Appellant has inserted few buzzwords in claim limitations and expecting the same words from the reference, which is an impossible situation, functionally the reference teaches the same concept as the current invention (see In re Schreiber, 44 USPQ2d 1429, CAFC 1997).

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Claim 4 – is also a dependent on claim 1 and rejected under the same rationale as the dependent claim 3 because of the same limitations.

Claims 7 – contains same limitations as the independent claim 1 and it is also rejected under the same rationale as the claim 1. Claims 1 and 7 are grouped together during the rejection.

Claims 9 and 12 – these two independent claims have the same limitations as the claim 1 and rejected under the same rationale as claim 1. Claims 9 and 12 are also grouped with claim 1 during the rejection.

Claim 11 – this claim is dependent on claim 9 and the limitations are similar to claim 3 and rejected under the same rationale as claim 3.

Claim 13 – this independent claim is related to system and the limitations of claim 1 and claim 13 are similar and they were grouped and rejected under the same rationale as claim 1.

Claims 14 and 17 – again these are independent claims and their limitations are the same as the claim 1 and they were grouped with claim 1 and rejected under the same rationale.

Claim 16 – this is a dependent claim on claim 14 and the limitations are similar to 4 as stated by the Appellant in the Appeal Brief and in turn it has similar to claim 3 limitations. So, this claim is grouped with the claim 3 and rejected under the same rationale.

Claim 18 – finally, this is an independent claim relating to a system. Since, the limitations of all independent claims are similar and they are grouped with claim 1 and rejected under the same rationale.


Conclusion

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The references disclose the claimed invention of sending messages to one or more recipients and sending a reminder notification to nonresponsive recipients. In addition to this, the secondary reference teaches a method of sending reminder notifications on scheduled basis. Milewski reference is considered as the primary reference and it teaches creating a message and sending to one or more recipients and receiving the response from the server in the form of a report listing the responses received and comments of recipients. Whereas Ariyama reference explicitly teaches sending message notifications on scheduled basis. Both references teach sending messages and reminder notifications. The two references used to reject all the claims and its limitations do teach the method of creating messages , sending messages and sending scheduled reminder notifications to recipients of one or more. In light of the foregoing arguments, the Examiner respectfully requests the honorable Board of Appeals and Interferences to sustain the rejection.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Sathyannarayan Pannala
Examiner
Art Unit 2167

srp
October 15, 2004

Conferees

- 1) John Breene, Supervisory Primary Examiner, Art Unit 2167
- 2) Joseph Field, Supervisory Primary Examiner, Art Unit 2176

Handwritten signatures of John E. Breene and Joseph Field. The signature for John E. Breene is written above the signature for Joseph Field.

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